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| EXAMINER HARRELL, ROBERT B | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/806,687

Applicant(s)

PROEHL, ANDREW MARK

Examiner

Robert B. Harrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2010 et seq.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-13,15-17,19 and 20 is/are pending in the application.
4a) Of the above claim(s) 8,10-13,15-17,19 and 20 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1 and 3-7 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 24 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Drafts/Person's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

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1. Claims 1, 3-7, 8, 10-13, 15-17, 19, and 20 remain presented in this application.
2. Claims 8, 10-13, 15-17, 19, and 20 have been withdrawn.
3. Claims 1 and 3-7 remain presented for examination.
4. The finality of examiner's Final Office Action, mailed 19 November 2009, is hereby vacated to permit entry and consideration of the applicant's 19 January 2010 remarks. Hence, the Appeal Brief filed 13 May 2010 is moot as the application was not ripe at the time. However, this Office Action is again made FINAL since it could have been so done even if examiner's 19 November 2009 Office Action was non-final as there are no new grounds of rejection subsequent the 19 November 1009 Office Action.
5. The applicant's 23 June 2009 election of Group I (claims 1 and 3-7), without traverse, is acknowledge; hence, the 10 December 2008 restriction requirement is hereby again made FINAL and incorporated by reference, as continued, in this FINAL Office Action.
6. The applicant should always use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., *provide proper antecedent basis for "the" and "said" within each claim*) with each claim ending in a period. Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.
7. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the reference is cited* and relied upon in this action as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions.
8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United

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States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

9. **Claims 1 and 3-7 are rejected under 35 U.S.C. 102 (e)** as being anticipated by Karas et al. (United States Patent Application Publication Number: US 2003/0130907 A1).

10. Per claim 1, Karas method (e.g., see Abstract (line 1)) for interacting with a user (e.g., see figure 1 (110)) over a peer-to-peer network (e.g., see figure 1 (150)) comprising:

- a) receiving (e.g., see figure 12A (1228)) a file (e.g., Greeting Card per figure 12(A)) from a user (e.g., see figure 1 (110)) via a third party (e.g., see figure 1 (140, and/or 190, and/or 142));
- b) receiving with the file an alias (e.g., see paragraph [0100]) identifying the user and a content rating (e.g., see paragraph [0072]) from the user, the content rating providing an indication of the user's rating of the file;
- c) storing in the third party identity information about the user in association with the alia (e.g., see figure 13 (1312) and paragraph [0090]-et seq.); and,
- d) linking the alias to a valid legal identity of the financial account while maintaining control and privacy over the valid legal identify and the financial account (e.g., see figure 16 (1608) and paragraph [0104]-et seq.);).

11. Per claim 3, claim 4, and claim 5, Karas also taught that the user can select one or more information elements within identity information that can be sent along with the alias per figure 7A (containing user's identification "Uncle Nick") and figure 7B absent the user's identification. Since claim 4 and claim 5 recite "one or", the scope does not mandate all; here the name "Uncle Nick" reads on claim 4; while not shown, it was customary, and common, and thus anticipated, to add an age to the Birthday Greeting Card (i.e., "Happy 18th Birthday").

12. Per claims 6 and 7, these claims do not teach or defined above the correspondingly rejected claims given above, and are thus rejected for the same reasons given above. However, per claim 6's aggregation, paragraph [0072 (line 8)] clearly taught "product reviews", in the plural. Also, paragraph [0071] taught that the Greeting Card has a greeting portion 704 which could include moving picture (i.e., "movie") and thus sound and/or music. Thus it was anticipated that the sender could send the Greeting Card with a song, in the message portion 704, along with the disclosed rating of paragraph [0072].

13. **The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this office action:**

a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to

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which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. **Claims 1 and 3-7 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Karas et al. (United States Patent Application Publication Number: US 2003/0130907 A1).

15. Obviousness from a prior art reference would follow, ipso facto, if prior art reference anticipates. See RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1446, 221 USPQ 385, 390 (Fed. Cir. 1984), citing In re Kalm, 378 F.2d 959, 962, 154 USPQ i0, 12 (CCPA 1967), (anticipation stated as being the "epitome of obviousness"). Also, the question is not whether the combination was obvious to the applicant but whether the combination was obvious to a person with ordinary skill in the art (KSR INTERNATIONAL CO. v. TELEFLEX INC. ET AL. (United States Supreme Court (Decided April 30, 2007))).

16. Per claim 6, paragraph [0071] taught that the Greeting Card has a greeting portion 704 (e.g., see figure 10) which could include animation or moving pictures. Thus it would have been obvious to those skilled in the art for the sender to send a Greeting Card with a humorous message content 704, and a content rating such as, "Everyone In The Office Likes This One".

17. The rejections, and grounds for rejections, under 35 U.S.C. 102(e) and under 35 U.S.C. 103(a) as presented in examiner's prior Office Action, mailed 19 November 2009, are each hereby maintained and incorporated in this Office Action by reference.

18. The applicant argued, the rejections under 35 U.S.C. 102(e) and 35 U.S.C. 103(a) in a combined manner, in his 19 January 2010 response by stating in substance that claims 1 and 3-7 were rejected under 35 U.S.C. 102(c) as being anticipated by newly- cited Karas (US Patent Application Publication No. US 2003/0130907 A1) and also under 35 U.S.C. 103 (a) as being unpatentable over Karas. In view of the following comments, the applicant respectfully traverses this rejection and requests reconsideration. Karas is directed to "electronic gift linking", in which an electronic greeting card provides an embedded 'code' that is indicative of the gift. Independent Claim 1 is directed to a method for interacting with a user over a peer-to-peer network, including receiving a file from a user via a third party, receiving with the file an alias identifying the user and a content rating from the user, the content rating providing an indication of the user's rating of the file, storing in the third party identity information about the user in association with the alias, and linking the alias to a valid legal identity and financial account while maintaining control and privacy over the valid legal identity and the financial account. Again, independent Claim 1 was previously amended to include the limitations of original dependent Claim 2, and specifically to clarify that the content rating from the user provides an indication of the user's rating of the file. Independent Claim 6 recites each of the elements of Claim 1 and further recites the step of aggregating by the third party a content ranking with a plurality of other content rankings from other users and making this available to others without identification of the users or aliases. The applicant respectfully directs the Examiner at least to paragraphs [0021], [0026] and [0027], and to Figure 3, 'rating 33', of the applicant's specification as filed. As described therein, a meta data file is attached to transferred content, and "each

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recipient 31, 32 of the content file 34 receives a history of who sent the content and the rating 33 these people applied to the content 34" (i.e., the 'recommendations' or 'ratings' of the person sending the content are provided to the recipients of that content). The applicant respectfully submits that Karas fails to teach or suggest this element. With regard to the recited step of receiving a file including a content rating from the user, the content rating providing an indication of the user's rating of the file, the Action directs Applicant to paragraph [0072] of Karas. In paragraph [0072], Karas describes how a sender 110 may include a 'personalized portion 708' in a card "with possible hot links to information". Karas notes: "when creating the eCard, certain predetermined information is 'made available ', such as, product information, retailer information, manufacturer information, product reviews, tracking information, warranty information, content ratings, safety ratings, recall information, frequently asked questions, care instructions, clearing status of a money transfer,...." The applicant submits that Karas does not teach or suggest that a method of interacting with a user in a peer-to-peer environment, including receiving a file from a user via a third party, and receiving with the file, an alias identifying the user and a content rating from the user, the content rating providing an indication of the user's (i. e., the person sending the file) rating of the file - rather in Karas, only 'predetermined information' is 'made available'. There is simply no teaching or suggestion in Karas that an indication of the user's rating (the "user" being the person who is sending the file) is provided with the file. In addition, even the information 'available' is not a 'rating' regarding the file - as noted in paragraph [0031] of Karas, a "code indicative of the gift is created... [and] facilitates retrieving information about the gift" (the 'file' sent in Karas is an electronic greeting card (see Examiner's assertion in paragraph 9, line 3 - "a file (i.e., Greeting Card per figure 12(A))" - the code that is embedded into the card allows the recipient to retrieve information about the gift (again, not about the 'card' (or file), and not including any rating information from the sender about the e-card). For at least these reasons, the applicant respectfully submits that independent Claim 1 is patentable over Karas, and reconsideration is requested. Again, independent Claim 6 recites each of the elements of Claim 1 and further recites the step of aggregating by the third party a content ranking with a plurality of other content rankings from other users and making this available to others without identification of the users or aliases. The Action states (para. 11) that "paragraph [0072 (line8)] (of Karas) clearly taught 'product reviews', in the plural...". Again, the applicant traverses this reading of Karas - and submits that Karas does not teach or suggest that a review "of the person sending the file" is provided to the recipient (para. [0072] of Karas states that "when creating the eCard, certain predetermined information is" made available, such as product information" - this does not provide any teaching or even suggestion of sending a file to a recipient, wherein the recipient receives with the file an alias identifying the user and a content rating of that file from the user). With regard to the 103(a) rejection, paragraph 15 of the Action takes the position that "paragraph [0071] (of Karas) taught that the Greeting Card has a greeting portion 704 which could include animation or moving pictures [and] thus it would have been obvious..., for the sender to send a Greeting Card with a humorous message content 704, and a content rating such as 'Everyone in the Office Likes This One'" (emphasis added herein). The applicant respectfully traverses this alleged 'obvious' modification of the actual teachings of Karas. In fact, Karas describes only that a sender "chooses a greeting portion 704 of the card 700 that might have a cartoon, animation, picture, moving picture, and/or message" - this simply does not teach, or even suggest, that a recipient of such an eCard in Karas would receive a content file

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with a rating that the sender applied to the content (again, see para. [0021] of the applicant's specification, "each recipient 31, 32 of the content file 34 receives a history of who sent the content and the rating 33 these people applied to the content 34"). The Examiner is attempting to read something into the teachings of Karas that simply is not provided by Karas. For at least the foregoing reasons, Applicant respectfully submits that Claim 6 is patentable over Karas. However, the applicant's directing of the Examiner at least to paragraphs [0021], [0026] and [0027], and to Figure 3, 'rating 33', of the applicant's specification as filed, as described therein, a meta data file is attached to transferred content, and "each recipient 31, 32 of the content file 34 receives a history of who sent the content and the rating 33 these people applied to the content 34" (i.e., the 'recommendations' or 'ratings' of the person sending the content are provided to the recipients of that content) is not what is claimed in such narrowing terms and thus moot. As to user's rating, as indicated above, one of Karas's preferred embodiment was that of a scooter (paragraph [0072]), but any item on the market, including movies or songs (MP3), could have been anticipated, or be obvious, as the product being sent along with the eCard. Furthermore, as indicated above, the eCard had embedded code that permitted for "moving pictures" (e.g., see paragraph [0071]). Thus it would have been obvious to those skilled in the art for the sender to send a Greeting Card with a humorous message content in 704, and a content rating such as, "Everyone In The Office Likes This One". That is, it would have been obvious to one skilled in the art for the sender to make a comment about the animated portion of the card itself. (i.e., "I Hope You Like This Card As Much As I do").

19. This action is again made FINAL (see paragraph 4 above).

20. This application contains non-elected claim drawn to an invention nonelected without traverse in the reply filed 23 June 2009. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01.

21. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Thursday from 5:30 am to 2:00 pm.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Asad Nawaz, can be reached on (571) 272-3988. The fax phone number for all papers is (571) 273-8300.

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24. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Robert B. Harrell/
ROBERT B. HARRELL
PRIMARY EXAMINER

/Asad M Nawaz/
Supervisory Patent Examiner, Art Unit 2442